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DOCKET NO.: UPN-3827



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of:

Amos B. Smith III, et al.

Confirmation No.: 7967

Application No.: 09/730,929

Group Art Unit: 1625

Filing Date: December 6, 2000

Examiner: Aulakah, Charanjit

For: COMPOUNDS WHICH MIMIC THE CHEMICAL AND BIOLOGICAL
PROPERTIES OF DISCODERMOLIDE

DATE OF DEPOSIT:

June 10, 2003

I HEREBY CERTIFY THAT THIS PAPER IS BEING
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Walter C. Frank
TYPED NAME: Walter C. Frank
REGISTRATION NO.: 52,911

Office of Initial Patent Examination
Customer Service Center
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CORRECTED FILING RECEIPT

Attached is a copy of the Official Filing Receipt received from the United States Patent and Trademark Office in the above application for which issuance of a Corrected Filing Receipt is respectfully requested. The requested changes are noted thereon, as well as listed below.

The subject continuation-in-part application was filed on December 6, 2000 with an unexecuted Declaration listing bibliographic information for inventors Amos B. Smith III, Thomas J. Beauchamp, Matthew J. LaMarche and Hirokazu Arimoto, which bibliographic information was initially drawn from the parent application.

On January 25, 2001 a Filing Receipt under confirmation number 7967 was issued by the PTO in respect of this Application reflecting the bibliographic information as provided on the unexecuted Declaration.

On January 25, 2001 a Notice to File Missing Parts of Nonprovisional Application was issued by the PTO requiring, among additional items, that an executed oath or declaration be entered in this Application.

On August 24, 2001, Applicant, by its Attorneys-of-Record, filed a Response to Notice to File Missing Parts of Application, a copy of which filing as transmitted to the PTO is enclosed herewith. In this Response to File Missing Parts of Application, an executed Declaration and Power of Attorney pursuant to CFR 1.63(e) was duly entered, which Declaration and Power of Attorney was executed by inventors Amos B. Smith, III, Thomas J. Beauchamp and Matthew J. Lamarche. In this particular case, fewer inventors were named in the executed declaration for the present application than had been named in the parent application. Applicant notes that a corrected Filing Receipt did not issue in this Application subsequent to the entrance of the executed Declaration.

Accordingly, pursuant to CFR 1.48(f)(1), Applicant kindly requests the PTO issue a Corrected Filing Receipt to reflect only those inventors having executed the Declaration and Power of Attorney as filed in the Response to Missing Parts in this application -- inventors Amos B. Smith, Thomas J. Beauchamp and Matthew J. Lamarche.

Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.

Date:

June 10, 2003



Walter C. Frank

Registration No. 52,911

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

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Page 1 of 4

JUN 30 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/730,929	12/06/2000	1626	413	UPN-3827	48	22	4

CONFIRMATION NO. 7967

FILING RECEIPT



OC000000005707049

Gregory L. Hillyer
Woodcock Washburn Kurtz
Mackiewicz & Norris LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103**RECEIVED**

FEB 06 2001

Woodcock Washburn Kurtz
Mackiewicz & Norris LLP

Date Mailed: 01/25/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)Amos B. Smith III, Merion, PA;
Thomas J. Beauchamp, Media, PA;
Matthew J. LaMarche, Philadelphia, PA;
~~Hirokazu Annote, Shizuoka, JAPAN;~~**Continuing Data as Claimed by Applicant**THIS APPLICATION IS A CIP OF 09/455,649 12/07/1999 3749
WHICH IS A CIP OF 09/021,878 02/11/1998 PAT 6,031,133 3358
WHICH IS A CIP OF 08/759,817 12/03/1996 PAT 5,789,605 2950**Foreign Applications**

If Required, Foreign Filing License Granted 01/23/2001

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Compounds which mimic the chemical and biological properties of discodermolide

Preliminary Class

549

Data entry by : TERFA, SEBLE

Team : OIPE

Date: 01/25/2001

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 36 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15 (b).

PLEASE NOTE the following information about the Filing Receipt:

- The articles such as "a," "an" and "the" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
- The docket number allows a maximum of 25 characters.
- If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
- The title is recorded in sentence case.

Any corrections that may need to be done to your Filing Receipt should be directed to:

Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, DC 20231

RECEIVED BY THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Paper: Notice to file Missing Parts of Nonprovisional Application dated January 25, 2001; Response to Notice to File Missing Parts of Application and Request for five month extension of time, in dup.; Executed Combined Declaration and Power of Attorney; an Associate Power of Attorney; and a check in the amount of \$1010 for filing Missing Parts, all sent via express mail label no EL 56809074 US.

Applicant(s) : Amos B. Smith, III; Thomas J. Beauchamp; Matthew J. LaMarche

Title: Compounds Which Mimic the Chemical and Biological Properties of Discodermolide

Serial No.: 09/730,929

Filed: December 6, 2000

Docket No.: UPN-3827

Date Sent: August 24, 2001 MD/JL/GLH/spuckett



RECEIVED BY THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Paper: Notice to file Missing Parts of Nonprovisional Application dated January 25, 2001; Response to Notice to File Missing Parts of Application and Request for five month extension of time, in dup.; Executed Combined Declaration and Power of Attorney; an Associate Power of Attorney; and a check in the amount of \$1010 for filing Missing Parts, all sent via express mail label no EL 56809074 US.

Applicant(s) : Amos B. Smith, III; Thomas J. Beauchamp; Matthew J. LaMarche

Title: Compounds Which Mimic the Chemical and Biological Properties of Discodermolide

Serial No.: 09/730,929

Filed: December 6, 2000

Docket No.: UPN-3827

Date Sent: August 24, 2001 MD/JL/GLH/spuckett





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DOCKET NO. UPN-3827

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Smith et al.

Group Art Unit: 1626

Examiner: not yet assigned

For: COMPOUNDS WHICH MIMIC THE
CHEMICAL AND BIOLOGICAL
PROPERTIES OF DISCODERMOLIDE

DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name; and

I believe that I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a

☒ Utility Patent ☐ Design Patent

is sought on the invention, whose title appears above, the specification of which:

☐ is attached hereto.

☒ was filed on December 6, 2000 as Serial No. 09/730,929.

☐ said application having been amended on _____.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to be material to the patentability of this application in accordance with 37 CFR § 1.56.

hereby claim foreign priority benefits under 35 U.S.C. § 119(a-d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of any application on which priority is claimed:

Priority Claimed (If X'd)	Country	Serial Number	Date Filed
<input type="checkbox"/>	_____	_____	_____
<input type="checkbox"/>	_____	_____	_____
<input type="checkbox"/>	_____	_____	_____
<input type="checkbox"/>	_____	_____	_____

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to be material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

Serial Number	Date Filed	Patented/Pending/Abandoned
<u>09/455,649</u>	<u>12/7/99</u>	<u>Pending</u>
<u>09/021,878</u>	<u>02/11/98</u>	<u>Issued</u>
<u>08/759,817</u>	<u>12/03/96</u>	<u>Issued</u>

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

Serial Number	Date Filed
_____	_____
_____	_____

DOCKET NO. UPN-3827

- 3 -

PATENT

I hereby appoint the following persons of the firm of **WOODCOCK WASHBURN KURTZ MACKIEWICZ & NORRIS LLP**, One Liberty Place - 46th Floor, Philadelphia, Pennsylvania 19103 as attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Mark DeLuca Reg. No. 33.229


Joseph Lucci Reg. No. 33.307

Gregory L. Hillyer Reg. No. 44.154

Address all telephone calls and correspondence to:

Gregory L. Hillyer
**WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP**
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone No.: (215) 568-3100
Facsimile No.: (215) 568-3439


I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: Amos B. Smith, III	 Signature
Mailing Address: 517 General Lafayette Road Merion, PA 19066	Date of Signature: <u>07/24/01</u>
City/State of Actual Residence: Merion, PA 19066	Citizenship: <u>USA</u>

DOCKET NO. UPN-3827

- 4 -


PATENT

Name: Thomas J. Beauchamp	 Signature Date of Signature: <u>8-24-01</u> Citizenship: <u>United States of America</u>
Mailing Address: 7277 Leawood Michigan Portage, Michigan 49024	
City/State of Actual Residence: Portage, Michigan	

Name: Matthew J. LaMarche	 Signature Date of Signature: _____ Citizenship: <u>United States of America</u>
Mailing Address: 2225 2F Locust Street Philadelphia, PA 19103	
City/State of Actual Residence: Philadelphia, PA 19103	

Name:	 Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	

Name: Thomas J. Beauchamp	Signature Date of Signature: _____ Citizenship: <u>United States of America</u>
Mailing Address: 7277 Leawood Michigan Portage, Michigan 49024	
City/State of Actual Residence: Portage, Michigan	

Name: Matthew J. LaMarche	 Signature Date of Signature: <u>8/23/01</u> Citizenship: <u>United States of America</u>
Mailing Address: 2225 27 Locust Street 2300 PINE ST Philadelphia, PA 19103 Apt. 12	
City/State of Actual Residence: Philadelphia, PA 19103	

Name:	Signature Date of Signature: _____ Citizenship: _____
Mailing Address:	
City/State of Actual Residence:	



UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/730,929	12/06/2000	Amos B. Smith III	UPN-3827

CONFIRMATION NO. 7967

FORMALITIES LETTER



OC000000005707050

Gregory L. Hillyer
Woodcock Washburn Kurtz
Mackiewicz & Norris LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

Date Mailed: 01/25/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 65.

The application is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given **TWO MONTHS** from the date of this Notice within which to correct the informalities indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
 - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

A copy of this notice MUST be returned with the reply.

Seble Bekele

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE